

REMARKS

This responds to the Office Action mailed on June 9, 2008.

Claims 1, 35, 56, 67, 70, 121 and 164 are amended, no claims are canceled, and no claims are added; as a result, claims 1-8, 10-31, 35, 39-59, 61, 62, 67-70, 121, 122, 132, 133, 139, 141, 143-145, 147-151, 154-168, 184, 187 and 191 are now pending in this application.

Interview Summary

Applicant thanks Examiner Vickey Ronesi for the courtesy of a telephone interview on May 15, 2008 with Applicant's representative Benjamin C. Armitage, in which we discussed possible amendments to the independent claims.

Rule 132 Declarations

Two Rule 132 Declarations are herewith submitted for consideration. The Declarations are authored by Charles J. Ray, Ph.D., Technical Director and Vice President of Deft Inc. (Assignee of the present application) and Richard Albers, Project Leader of Deft Inc. The Declarations are discussed below.

Double Patenting Rejection

Claims 1-7, 15, 17, 35, 42-45, 70 and 151 were provisionally rejected under a non-statutory obviousness-type double patenting rejection, specifically over claims 39-41 of co-pending U.S. Patent Application No. 10/758,973 (published as U.S. Patent Application Publication No. 2004/0186201).

Claims 1, 13 and 14 were provisionally rejected under a non-statutory obviousness-type double patenting rejection, specifically over claim 13 of co-pending U.S. Patent Application No. 11/036,416 (published as U.S. Patent Application Publication No. 2006/0063872).

Applicant notes the provisional nature of this rejection, and will consider filing a Terminal Disclaimer in compliance with 37 CFR 1.321(b)(iv) should the co-pending application issue prior to issuance of the above claims herein to obviate these rejections.

§112 Rejection of the Claims

Claims 1-8, 10-22, 30, 31, 35, 39-59, 61, 62, 67-70, 121, 122, 132, 133, 139, 141, 143-145, 147-151, 160, 161, 164-168, 184, 186, 187 and 191 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Applicant has amended the independent claims to remove the rejected phrase “curable in air.” Because the amendments obviate the written description requirement, it is respectfully requested that the rejection be removed.

§102 Rejection of the Claims

Claims 1, 7, 10, 11, 13, 14, 17, 19, 56-58, 141, 143-145 and 164-166 were rejected under 35 U.S.C. § 102(b) for anticipation by Takeuchi et al. (JP 05-117589).

Independent claims 1, 56 and 164 have been amended to include the phrase “wherein the corrosion inhibiting coating composition is capable of curing by air drying.” Explicit support for this amendment can be found in the application as filed in at least paragraphs [0071] on page 25, [0096] on page 37 and [0100] on page 51. One skilled in the art recognizes this limitation as not only requiring the presence of air, but also that air drying occurs at an ambient temperature, without the addition of heat or other forces. As an example, the present application discusses “drying naturally” as opposed to drying using accelerating methods (see paragraph [0027] on page 9). Air drying is analogous to drying naturally, in the same way that UV drying or heating are analogous to accelerated drying methods as discussed in the application.

In the Takeuchi reference, at paragraphs [0008] and [0011], the coating must be baked in air to detach the organic side chains and leave a thin ceramic coating. Suggested temperatures show heating at 400-450°C. The examples show heating of up to 500 °C in multiple steps. The Takeuchi reference does not disclose a corrosion inhibiting coating composition curable in air. It is respectfully requested that the rejection be withdrawn.

§103 Rejection of the Claims

Claims 2, 3, 67, 68 and 150 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi et al. (JP 05-117589).

As the Takeuchi reference does not disclose a corrosion inhibiting coating composition capable of air drying, not all elements of the present claims are found in the reference and therefore, a *prima facie* case of obviousness has not been established.

Claims 1-8, 10-20, 30, 31, 56-59, 61, 62, 67-69, 139, 141, 143-145, 147-150, 164-168 and 184 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. Patent No. 6,190,780).

Independent claims 1, 56, 67 and 164 were amended to include “wherein the corrosion inhibiting coating composition is capable of air drying.” The Shoji reference does not disclose such an element. The reference discusses heat treatment in the range of 100-200 °C in Column 11, lines 19-33. Example 1 also teaches the heat treatment of a mixture at 100-200 °C to create a paste-like substance. The Examiner asserts that heating is not required in Shoji if a resin is added (see column 11, lines 31-33), but in fact heating is still required. Shoji discusses adding a resin to the oxyacid, but this addition occurs during the method described in lines 19-31 which require heating. Because not all elements of the present claims are found in the reference and therefore, a *prima facie* case of obviousness has not been established.

Additionally, although Applicant does not admit that a *prima facie* case of obviousness has been established, two Rule 132 Declarations have been provided for consideration. The evidence of a long felt need in the field and commercial success of a product covered by the claims of the present invention rebut any obviousness rejection.

The remaining claim rejections are to dependent claims. In light of the amendment and arguments for patentability of the independent claims, it is believed the dependent claims are in condition for allowance.

Claims 21 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. Patent No. 6,190,780) in view of Oakes (U.S. Patent No. 4,370,256).

Applicant respectfully requests withdrawal of this rejection on the grounds discussed above, because neither Oakes, nor the accompanying reasoning in the Office Action appear to cure the deficiencies noted above.

Claims 35, 39-52, 54, 55, 70, 121, 122, 132, 133, 151, 160, 161, 186 and 187 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. Patent No. 6,190,780) in view of Reuter et al. (U.S. Patent Application Publication No. 2003/0082368).

Applicant respectfully requests withdrawal of this rejection on the grounds discussed above, because neither Reuter, nor the accompanying reasoning in the Office Action appear to cure the deficiencies noted above.

Claim 53 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. Patent No. 6,190,780) in view of Reuter et al. (U.S. Patent Application Publication No. 2003/0082368), and further in view of Tucker (U.S. Patent No. 3,837,894).

Applicant respectfully requests withdrawal of this rejection on the grounds discussed above, because Reuter, Tucker, nor the accompanying reasoning in the Office Action appear to cure the deficiencies noted above.

Claim 191 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. Patent No. 6,190,780) in view of Reuter et al. (U.S. Patent Application Publication No. 2003/0082368), and further in view of Koefod (U.S. Patent No. 5,531,931).

Applicant respectfully requests withdrawal of this rejection on the grounds discussed above, because Reuter, Koefod, nor the accompanying reasoning in the Office Action appear to cure the deficiencies noted above.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6920 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 9/24/08

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 24 day of July, 2008.

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